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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,941	03/31/2004	Martin Salzmann	5083-34	7875

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NEW YORK, NY 10176

EXAMINER

LE, THIEN MINH

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

8m

Office Action Summary	Application No. 10/814,941	Applicant(s) SALZMANN, MARTIN	
	Examiner Thien M. Le	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-18 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

The information disclosure statement and the foreign priority document both filed on 3/31/2004 have been entered. Claims 1-18 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 6-9, 11-13, and 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by List et al. (Patent Publication No. 2004/0225575 A1; List et al.; herein after referred to as "List").

List discloses a "system for selectively storing recorded material onto a storage medium such as a compact disc (CD) or digital video disc (DVD) includes a terminal having access to recorded material and configured to download recorded material selected by a user to a storage medium, and a dispenser connected to the terminal configured to distribute the storage medium to a user. A method of purchasing a customized storage medium, such as a CD or DVD includes the steps of accessing a terminal; selecting at least one recorded item; adding the at least one recorded item to a list; recording the at least one item to the storage medium; placing the storage medium in a case and dispensing the storage medium to a user. The system and method may also include storing sales data on a server and accessibility of the sales data on the server by a third party." (Abstract)

According to List, the system relates to a "method for custom designing and acquiring a compact disc (CD), digital video disc (DVD), or other storage medium having selected prerecorded music, movies, books and the like (collectively referred to as "recorded material") recorded thereon. A terminal having access to such recorded material may be publicly accessible in the form of a kiosk or vending machine, in places such as malls, airports, gas stations and the like. Alternatively, the terminal may be located within a retail establishment. A user may access the terminal and preview and select recorded materials that may be compiled and stored onto a storage medium such as a CD, DVD, MP3 and the like. The recorded material may include music, music video, recorded books, video movies, video games,

and the like. The user may pay directly at the terminal and the storage medium may be dispensed to the user. Alternatively, if the terminal is located within a retail establishment, the storage medium may be dispensed to the user to take to a cashier to complete the purchase.”

Figure 2 of List shows “a system 20” including “a terminal 22 that may be a remote public access computer similar to a vending machine or located in a kiosk, or may be a stand alone terminal located within a retail establishment as illustrated in FIG. 2. The user may access terminal 22 and participate in interactive communication with terminal 22 through menu driven software. The terminal 22 may include touch screen technology to allow the user to easily navigate through the software programs. Alternatively, the computer may utilize mechanical controls, such as button controls, located within terminal 22 and well known in the art.”

“Terminal 22, as illustrated in FIG. 2, includes a dispenser unit 24 for dispensing the storage medium created by the user (such as CD or DVD), a credit card/debit card acceptor unit 26, a cash acceptor unit 28, a receipt dispenser 29 and speakers 30. Speakers 30 enable the user to receive audio prompts or listen to previews of selected recorded material. Credit card/debit card acceptor 26 may be a standard credit card swipe device similar to those used at gas pumps or other self serve checkout stations. Likewise, cash acceptor 28 may be a cash acceptor and change dispenser device available in the art and commonly used for change machines. Terminal 22 may also include a seat or bench 33 to enable the user to sit comfortably at terminal 22 during operation of the programs.”

“Terminal 22 may include its own hard drive for storing recorded material and may also be communicatively connected to a supply server 32 as shown in FIG. 1. Supply server 32 may

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be located within the retail establishment, or at some other remote location. Supply server 32 may provide greater capacity, and access to a larger number of recorded materials to be made available for selection by a user. Both terminal 22 and supply server 32 may also be communicatively connected to the internet to provide even greater capacity and access to more recorded materials for the user to select from and add to their custom designed CD, DVD, and the like. The additional recorded materials may also be stored and available through a second terminal 35. Second terminal 35 may be connected to terminal 22 through the internet or directly through communication between terminal 22 and second terminal 35. These combinations of recorded material resources will increase the versatility and desirability of the present invention.”

As can be seen, List discloses a terminal 22 (which serves as the claimed computer unit) having a memory (figure 2); displaying means and interfaces allowing the user to select digital records such as music, video, etc., for previewing and purchasing (figures 2-3); and issuing device for issuing by recording multimedia productions (figures 2-3). Thus, List discloses the claimed invention.

Regarding claims 6 and 17, see the discussions regarding claim 1. Also see figures 1-2, 3a, 3b and pages 2-3 of List.

Regarding claims 7-9, 11, see the discussions above regarding claim 1. Further, List shows in figures 1, 2, 3a and 3b the system and method for automatically issuing recorded information in the form of CD, DVD, video, record music, game, etc., which thus implies the use of a CD burner, a DVD burner, etc.

Regarding claim 12, see figures for connections to one or more terminal(s) in a communication network.

Regarding claim 13, see the discussions above regarding claim 1 and figure 1 for server 32.

Regarding claim 18, List discloses that the display and keyboard interfaces could be replaced with a touch sensitive display (pages 2-3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-5, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over List et al. (Patent Publication No. 2004/0225575 A1; List et al.; herein after referred to as "List"; cited above) in view of Newell et al. (Newell et al. – 5,159,560; herein after referred to as Newell).

Regarding claim 2, see the discussions regarding claim 1.

The claim differs in calling for the use of a bar code reader for reading the multimedia packages.

Reference to Newell is cited as evidence showing the conventionality of the claimed limitation.

Specifically, Newell discloses a "system from which a customer may rent and return videocassettes. The system has a plurality of vending machines for dispensing and receiving videocassettes including a carousel rotated about a horizontal axis and having bins for storage of videocassettes and access doors for dispensing and receiving videocassettes. A computer controlled positioning system scans a barcode ring affixed to the carousel and an aperture detector counts the passage of apertures in a ring about the carousel for determining the position of the carousel. The control computer also maintains an inventory database which tracks inventory in the bins by scanning barcodes affixed to the each videocassette and viewable via an opening at each bin location. A host computer communicates with machine control computers

for maintaining a system wide inventory database, communicating with financial institutions for customer billing purposes, logging machine faults and controlling inter-vending of videocassettes, wherein inter-vending permits videocassettes rented from one machine within the system to be returned to another machine in the system and be re-rented from that machine with automatic adjustment of the inventory". (Abstract; figures 1, 2, 3a, and 3b).

It would have been obvious to modify List's system to include a multimedia renting system having a bar code reader.

The modification not only allows the customer to rent the movie, game, etc., but also allowing the customer with an option to purchase a copy of the movie, game, etc.; and thus would effectively increase the customer base of List's system.

Regarding claim 3, see the discussions regarding claim 2. Also see figures 1, 2, 3a, 3b and their descriptions.

Regarding claim 4, see the discussions above regarding claims 1-3. Specifically, List discloses a terminal 22 which includes a processor and a memory that serve as the claimed computer, a display unit, a speaker 30, a display (figure 2), user interfaces for receiving customer's inputs, and a scanner as has been discussed regarding to claim 2.

Regarding claims 5 and 10, List discloses the method of having a local hard drive or a remotely located host server for storing multimedia packages that can be connected to the terminal via the Internet which thus would embrace both wireless and/or wired types of Internet connections such as a typical wireless LAN interfaces.

Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over List et al. (Patent Publication No. 2004/0225575 A1; List et al.; herein after referred to as "List"; cited above) in view of Newell et al. (Newell et al. – 5,159,560; herein after referred to as Newell) and further in view of Parkkinen et al. (Patent Publication No. 2003/0206558 A1 – Parkkinen et al.; herein after referred to as Parkkinen).

Regarding to claims 14-16, see the discussions regarding claim 1.

The claims differs in calling for the method of storing multimedia information in compressed format, file and clip formats.

Reference to Parkkinen discloses the conventionality of the claimed limitations. Specifically, Parkkinen discusses the method of storing multimedia information in compressed format, file and clipped formats which can be selectively accessed (see paragraph 0070).

It would have been obvious to implement the method of storing the data in the manners as recited and suggested by Parkkinen. The modifications improve the processing time of the overall system.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Le, Thien Minh
Primary Examiner
Art Unit 2876
May 11, 2005